

REMARKS

Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

Claims 1-17 are pending in this application. By this Amendment, the specification and claims 1, 3-6, 8, 11-14, and 16 are amended, and claim 17 is added. Claims 1, 3-6, 8, 11-14, and 16 are amended for clarify, and not related to patentability. Claim 17 is similar to claim 1 without the "means-plus-function" format. No new matter is added. Claims 1, 16, and 17 are the independent claims.

Applicant notes with appreciation the Examiner's acknowledgement that certified copies of all priority documents have been received by the U.S.P.T.O.

Applicant appreciates the Examiner's indication that the Information Disclosure Statement filed on June 29, 2006, has been considered.

Applicant also respectfully notes the present action indicates that the drawings have been accepted by the Examiner.

Objections to the Specification

The disclosure is objected to because the foreign priority information was not included in the specification. Applicant has amended the specification to include the priority information. Withdrawal of the objection is respectfully requested.

Objections to the Claims

Claim 11 is objected to for informalities. In particular, the Examiner objected to the acronym "STMP". Applicant has amended claim 11 to obviate the objection. Withdrawal of the objection to the claim is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claims 1-4, 8, 9 and 14-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,691,156 ("Drummond") in view of U.S. Patent No. 6,351,764 ("Voticky"). Applicants respectfully traverse this rejection for the reasons discussed below.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), all of the claim limitations of the rejected claims must be described or suggested by the cited document(s).¹ Applicants respectfully submit that the cited documents do not meet this criterion, because no modification of the Drummond and the Voticky references will describe or suggest all of the claim limitations of rejected claims 1-4, 8, 9 and 14-16, and therefore, a *prima facie* case of obviousness has not been established.

For example, claim 1, as amended, recites, *inter alia*:

prioritizing means which, in response to recognition of the second message being a reply to the returned message, assigns a priority to each of the identification insignias of the senders of the first messages, and

means for selecting identification insignias and adding the selected insignias to the allowed list, wherein the means for selecting are adapted to carry out the selection according to the priorities assigned to the identification insignias.

In the outstanding Office Action, the Examiner admits that the filter of Drummond fails to disclose the features of the “prioritizing means” and “means for selecting identification insignias,” as taught by claim 1. However, the Examiner attempts to remedy the admitted deficiencies of Drummond by arguing that the Voticky reference teaches the missing features.² Applicant respectfully disagrees.

In particular, Applicant submits that the Voticky reference uses the insignia to assign a priority to an e-mail message. The result of the priority is then used to categorize a specific e-mail. For instance, claim 1 of Voticky recites:

....assigning a code for the received information message based on a result from a step of looking-up wherein the code is maintained in the database and corresponds to the unique identifier in the database;

prioritizing the received information message according to the code....

On the contrary, claim 1 of the present application discloses that the means for selecting and adding identification insignias to the allowed list is adapted to carry out the selection according to the priorities assigned to the identification insignias. In other words, claim 1 differs in two ways from the Voticky reference. Firstly, the priorities of claim 1 are assigned to the identification insignias, and not to the e-mails, as taught by Voticky. Secondly, the means for selecting identification insignia of claim 1 is also a means for adding the selected insignias to the allowed list. As such, the means may be adapted to carry out the selection according to the priorities.

Therefore, based on the above, the two features are not disclosed in Voticky, which on the contrary only prioritizes the e-mail itself, and which does not disclose

¹ See *In Re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See also MPEP § 2143.03.

² See Office Action mailed May 4, 2009, page 5, last two paragraphs.

that the prioritizing can be used when carrying out the adding of the insignias to the allowed list.

Accordingly, Applicant respectfully submits that the Drummond and Voticky references, individually or in combination, fail to disclose, or even suggest, “prioritizing means which, in response to recognition of the second message being a reply to the returned message, assigns a priority to each of the identification insignias of the senders of the first messages, and means for selecting identification insignias and adding the selected insignias to the allowed list, wherein the means for selecting are adapted to carry out the selection according to the priorities assigned to the identification insignias,” as recited in claim 1.

Since the rejection fails to disclose or suggest each and every element of the rejected claims, Applicant respectfully submits that no *prima facie* case of obviousness has been established with respect to claim 1.

Further, in order to establish a *prima facie* case of obviousness, the Examiner must establish that it would have been obvious for one of ordinary skill to have combined the teachings of the cited documents.³ One way to establish this would be to show “some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness” and “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.”⁴ Furthermore, the Examiner must make “*explicit*” this rationale of “the apparent reason to combine the known elements in the fashion claimed,” including a detailed explanation of “the effects of demands known to the

³ See *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. at 398, 82 USPQ2d at 1396 (2007).

⁴ *Id.*

design community or present in the marketplace” and “the background knowledge possessed by a person having ordinary skill in the art.”⁵

It is respectfully submitted that the Examiner has not met these criteria. For example, the Examiner asserts that:

[I]t would have been obvious to one of ordinary skill in the art at the time of invention was made to incorporate the teachings on Voticky’s method of filtering and prioritizing messages to Drummond’s method because this would reduce the number of unsolicited e-mail messages received by the recipient.

However, it is respectfully submitted that the above statement is merely conclusory and do not comprise an “*explicit rationale*” as required by *KSR Int’l*. Therefore, because the Examiner has not provided an explicit analysis as required by *KSR Int’l*, a *prima facie* case of obviousness has not been established.

In view of the above, Applicant respectfully submits that the Drummond and Voticky references, individually or in combination, fail to teach or suggest each and every element of claim 1, and, therefore, claim 1 is allowable over this cited art. Claims 2-15 are dependent from claim 1, and therefore, also allowable.

Claim 16 is directed to a method claim which corresponds to claim 1. Applicant respectfully submits that this claim is also allowable for the similar reasons presented above in regard to claim 1.

Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

⁵ *Id.*

Claims 5, 10, 11 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Drummond and Voticky in view of U.S. Patent Application Publication No. 2004/0205127 ("Ben-Yosef"). Applicants respectfully traverse this rejection for the reasons discussed below.

Claims 5, 10, 11 and 13 are believed to be allowable for at least the reasons set forth above regarding claim 1. The Ben-Yosef reference fails to provide the teachings noted above as missing from the Drummond and Voticky references. Since claims 5, 10, 11 and 13 are patentably at least by virtue of their dependency on claim 1, Applicant respectfully requests that the rejection of claims 5, 10, 11 and 13 under 35 U.S.C. § 103(a) be withdrawn.

Claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Drummond and Voticky and Ben-Yoseph in view of U.S. Patent No. 6,330,590 ("Cotten"). Applicants respectfully traverse this rejection for the reasons discussed below.

Claim 12 is believed to be allowable for at least the reasons set forth above regarding claim 1. The Cotten reference fails to provide the teachings noted above as missing from the Drummond and Voticky references. Since Claim 12 is patentably at least by virtue of their dependency on claim 1, Applicant respectfully requests that the rejection of claim 12 under 35 U.S.C. § 103(a) be withdrawn.

New Claim

Claim 17 has been added in an effort to provide further, different protection for Applicant's invention. For instance, claim 17 is similar to claim 16 without the "means-plus-function" language. Claim 17 is allowable at least for the reasons somewhat similar to those given for claims 1 and 16, and/or for the further features recited therein.

CONCLUSION

In view of the above remarks and amendments, Applicants respectfully submit that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. Further, the above remarks demonstrate the failings of the outstanding rejections, and are sufficient to overcome the rejections. However, these remarks are not intended to, nor need they, comprehensively address each and every reason for the patentability of the claimed subject matter over the applied prior art. Accordingly, Applicants do not contend that the claims are patentable solely on the basis of the particular claim elements discussed above.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) hereby petition(s) for a three (3) months extension of time for filing a reply to the outstanding Office Action and submit the required \$555 extension fee herewith.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned, at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By



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